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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,813	04/05/2005	Toshio Narita	042393	6606
38834 7590 08/14/2007 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			EXAMINER WONG, EDNA	
			ART UNIT 1753	PAPER NUMBER
			MAIL DATE 08/14/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/501,813	Applicant(s) NARITA ET AL.	
	Examiner Edna Wong	Art Unit 1753	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 August 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

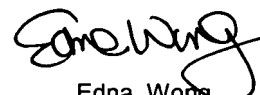
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 2 and 6.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See pages 2-6.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


Edna Wong
Primary Examiner
Art Unit: 1753

ADVISORY ACTION

Response to Amendment

This is in response to the Amendment After Final dated August 2, 2007. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

Claim Rejections - 35 USC § 103

Claims **1-2 and 6** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **Castonguay** (US Patent No. 3,857,683) in combination with **Phillips** (US Patent No. 3,704,211).

The rejection of claims 1, 2 and 6 under 35 U.S.C. 103(a) as being unpatentable over Castonguay in combination with Phillips is as applied in the Office Action dated May 18, 2007 and incorporated herein. The rejection has been maintained for the following reasons:

Applicants state that nothing in Castonguay and Phillips teaches or suggests how such a high-Re-content alloy film is obtained.

In response, the Examiner maintains that Castonguay and Phillips teaches the method step of present claim 1:

performing an electroplating process using an electroplating bath which contains an aqueous solution including:
a perrhenate ion in a concentration of 0.1 to 8.0 mol/L;
at least one ion selected from the group consisting of nickel, iron, cobalt

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and chromium (III) ions, in a total concentration of 0.005 to 2.0 mol/L;
at least one of a Li ion and a Na ion, in a total concentration of 0.0001 to 5.0 mol/L; and
at least one organic acid selected from the group consisting of carboxylic acid, hydroxycarboxylic acid and amino acid, in a concentration of greater than 5.0 to 15.0 equivalents to the concentration of all of said metal ions,
wherein said electroplating bath has a pH of 0 to 8, and a temperature of 10 to 80°C.

This method step forms the high-Re-content alloy film which contains Re at 98% or more by atomic composition.

This method step is taught by the combination of Castonguay and Phillips, e.g., 4.5-5.5 g/l Na (= 0.20 to 0.24 mol/l Na) [Phillips, col. 4, line 43] in the bath of Example XXIII (Castonguay, col. 9, lines 21-36).

This method step does not distinguish the method over the prior art because:

(a) Similar processes can reasonably be expected to yield products which inherently have the same properties. *In re Spada* 15 USPQ 2d 1655 (CAFC 1990); *In re DeBlauwe* 222 USPQ 191; *In re Wiegand* 86 USPQ 155 (CCPA 195);

(b) If the composition is physically the same, it must have the same properties;

(c) A preamble is not necessarily accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. *In re Hirao* 535 F. 2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie* 187 F 2d 150, 152, 88 USPQ 478, 481 (CCPA 1951);

(d) The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by the Applicants. *In re Linter* 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Dillon* 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), *cert. denied*, 500 US 904 (1991); and MPEP § 2144.; and

(e) The claims attempt to define the subject matter in terms of the result to be achieved, which merely amounts to a statement of the underlying problem, without providing the technical method features necessary for achieving this result.

Applicants state that in Example XXIII, Castonguay further describes: "By varying the rhenium content in the bath from 3 to 80%, the rhenium content in the deposit may be varied from 25 to 95%" and in Example XLV, Castonguay further describes: "By varying the rhenium content in the bath from 6 to 98%, the rhenium content in the deposit may be varied from 75 to 95%."

In response, these statements does not change the method step of present claim 1:

performing an electroplating process using an electroplating bath which contains an aqueous solution including:

- a perrhenate ion in a concentration of 0.1 to 8.0 mol/L;
- at least one ion selected from the group consisting of nickel, iron, cobalt and chromium (III) ions, in a total concentration of 0.005 to 2.0 mol/L;

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at least one of a Li ion and a Na ion, in a total concentration of 0.0001 to 5.0 mol/L; and
at least one organic acid selected from the group consisting of carboxylic acid, hydroxycarboxylic acid and amino acid, in a concentration of greater than 5.0 to 15.0 equivalents to the concentration of all of said metal ions, wherein said electroplating bath has a pH of 0 to 8, and a temperature of 10 to 80°C.

Furthermore, the concentrations of the ions and the organic acid taught by Castonguay and Phillips overlap with the concentrations of the ions and the organic acid in the method step of present claim 1.

Applicants state that in Castonguay, weight percentage is used.

In response, mol/L is used in the method step of present claim 1, and g/l is used in the method of Castonguay and Phillips.

Applicants state that Castonguay cannot obtain high-Re-content alloy containing Re at 98% or more.

In response, inoperativeness of a reference is not established by merely showing that a particular disclosed embodiment is lacking in perfection does not establish non-obviousness. *Ex parte Allen* 2 USPQ 2d 1425 (BPAI 19870; *Decca Ltd. V. United States* 191 USPQ 439 (Ct. Cl. 1976); *Bennett v. Halahan* 128 USPQ 398, 401 (CCPA 1961).

Furthermore, the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by the Applicants. *In re Linter* 458 F.2d 1013, 173 USPQ

560 (CCPA 1972); *In re Dillon* 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), *cert. denied*, 500 US 904 (1991); and MPEP § 2144.

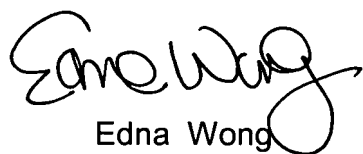
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (571) 272-1349. The examiner can normally be reached on Mon-Fri 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Edna Wong
Primary Examiner
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EW
August 10, 2007